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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,299	12/18/2001	Koichi Iijima	011660	4119

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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2192

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/017,299	Applicant(s) IIJIMA, KOICHI	
	Examiner Hoang-Vu A. Nguyen-Ba	Art Unit 2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1-9, 11-15, 17, 19 and 20 is/are allowed.
6) ☒ Claim(s) 10 is/are rejected.
7) ☒ Claim(s) 16 and 18 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>20060107</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed October 13, 2005 and the examiner-initiated telephone interviews on December 27, 2005, January 4 and 6, 2006.
2. Claims 1-20 are pending. Claims 1, 10, 11 and 20 are independent claims.

Response to Amendments

3. Per Applicant's request, claim 11 has been amended.

Response to Arguments

4. The rejection of claim 11 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter is withdrawn in view of Applicant's amendment to claim 11 to indicate that the method of claim is a computer-implemented method.
5. The previous Office action mailed to Applicant on June 14, 2005 has indicated that claims 1-10 and 12-20 are allowed. However, after consideration of claims 1-20 for allowance, the examiner found that independent claim 10 is not directed to statutory subject matter and considered not allowable over the prior art as previously indicated. The examiner has contacted Applicant's attorney to discuss tentative amendment to the claim language to direct claim 10 to statutory subject matter in order to expedite the issuance of this case. See attached Interview Summary. The following amendments to the claim language has been agreed to by Applicant's attorney and the examiner but not yet approved by the inventor as of Friday, January 6, 2006:

in claim 10, at line 7, after "unit", delete "." and insert -- , --; then on the next line (i.e., line 8) insert – wherein at least one of said first electronic unit and said second electronic unit performs a comparison of the magnitude of the version data of said second electronic unit and the support version data. –

In view of the foregoing, the examiner withdraws the indication of allowability of claim 10 and 16 and introduces new grounds of rejection of claim 10 and 16 and objection to the drawings for minor informalities hereinafter.

Drawings

6. The drawings are objected to because of the following minor informalities:
 - a. FIG. 13: in the block labeled "Proceed to MP..." shown below the block labeled "Report Incompatibility," "Shange" should read - Change -
 - b. FIG. 15: in the block at the end of the branch "Y" coming out of block S39, "Compatibirity" should read - Compatibility -
 - c. FIG. 17: lines 3, 7 and 11, "Histry" should read - History -
 - d. FIG. 20: in the block next to the label "S38," "Incompatibirity" should read - Incompatibility -

New corrected drawings in compliance with 37 CFR1.121(d) are required in reply to this Office action. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "said version" in "the step of changing said version" at line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 10 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10 is drawn to non-functional descriptive material. MPEP 2106.IV.B.1(a) (Non-functional Descriptive Material) states:

"Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. § 101."

"Where certain types of descriptive material, such as music, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing process performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer."

"For example, music is commonly sold to consumers in the form of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture."

2106.IV.B.1 (Nonstatutory Subject Matter) states:

“When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement.”

Claim 10 currently recites “[a] first electronic unit working in cooperation with a second electronic unit... having compatibility verification data ... , said compatibility verification data comprising: a support version data of said second electronic unit... ” and a version data of said first electronic... ” There is no functional relationship imparted by these data to a computing device. Therefore, the claim is drawn to nonfunctional descriptive material which is nonstatutory per se. The fact that the claim recites a computer-readable medium does not provide the utility (i.e., practical application in the technological arts) required under 35 U.S.C. § 101 for the manufacture.

Furthermore, the two electronic units in claim 10 do not appear to perform physical transformation of the claimed data to a different state.

Allowable Subject Matter

11. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, i.e., Kawanabe and the prior art made of record, i.e., U.S. Patent No. 6,694,335 to Hopmann et al. (“Hopmann”), U.S. Patent No. 6,061,683 to Alonso, U.S. Patent No. 6,842,264 to Leyva et al.(Leyva) and Class Version Number, taken individually or in combination, fail to teach or suggest a computer-implemented method for verifying compatibility in electronic equipment having a plurality of electronic equipment working in cooperation. Specifically, the prior art of record and made of record fail to teach the method steps claimed in Claims 11 and 20 and the equipment claimed in Claim 1.

12. Claims 16 and 18 are objected to as containing limitation that lacks proper antecedent basis, but would be allowable if rewritten to correct the identified discrepancy.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hoang-Vu A. Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday from 7:15 – 17:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Tuan Dam can be reached at (571) 272-3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Anthony Nguyen-Ba". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

ANTONY NGUYEN-BA
PRIMARY EXAMINER
January 7, 2006